DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-48, claims 2-6 and 9-11, drawn to a method for preventing and/or suppressing growth of transgenic plants expressing a nucleic acid molecule encoding a D-amino acid oxidase, selected from the group of SEQ ID NO: 2, 4, 6, 8, 10, 12, 14 and GenBank or SwisProt Acc. No. JX0152, 001739, 033145, 035078, 045307, P00371, P14920, P18894, P22942, P24552, P31228, P80324, Q19564, Q28382, Q7PWX4, Q7PWY8, Q7Q7G4, Q7SFW4, Q7Z312, Q82MI8, Q86JV2, Q8N552, Q8P4M9, Q8PG95, Q8R2R2, Q8SZN5, Q8VCW7, Q921M5, Q922Z0, Q95XG9, Q99042, Q99489, Q9ClL2, Q9JXF8, Q9V5P1, Q9VM80, Q9X7P6, QgY7N4, Q9Z1MS, Q9Z302, and U60066, respectively, comprising treating the transgenic plants with a compound which comprises a D-amino acid.

Group 49, claims 7-8, drawn to a herbidical composition, said composition comprising a D-amino acid.

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as Groups 1-49 appear to share the technical feature of composition comprising D-amino acids and utilizing the D-amino acids. The composition of claims 7-8 contain D-amino acids, and the method of claims 1-8 and 9-11 comprise treating transgenic plants comprising a nucleic acid sequence encoding a polypeptide which metabolizes D-amino acids with a D-amino acid. This technical feature is taught by Huffman and Ingersoll; The resolution of amino acids. II. Isoleucine, alloisoleucine, leucine, and norleucine. (1951) J. ACS; Vol. 73, pp. 3366-3369. Huffman and Ingersoll teach a solution comprising D-Isoleucine (see first line on Table 1 on page 3369). This prior art teaches that the shared technical feature of D-amino acids lacks novelty and does not make a contribution over the prior art.

Claim 1 links the inventions of groups 1-48.

The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant applications. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are

no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Groups 1-48

This application contains claims directed to multiple polynucleotide molecules. Each of these are patentably distinct from each other because the polynucleotides are each unique molecules with different chemical and structural features, and encodes polypeptides having different amino acid sequences. Applicants are reminded that nucleotide sequences encoding different proteins, and the amino acid sequences they encode, are structurally distinct chemical compounds and are unrelated to one another, and form different inventive steps or concepts.

Applicant is required to select one nucleotide sequence encoding one amino acid sequence selected from the group of SEQ ID NO: 2, 4, 6, 8, 10, 12, 14 and GenBank or SwisProt Acc. No. JX0152, 001739, 033145, 035078, 045307, P00371, P14920, P18894, P22942, P24552, P31228, P80324, Q19564, Q28382, Q7PWX4, Q7PWY8, Q7Q7G4, Q7SFW4, Q7Z312, Q82MI8, Q86JV2, Q8N552, Q8P4M9, Q8PG95, Q8R2R2, Q8SZN5, Q8VCW7, Q921M5, Q922Z0, Q95XG9, Q99042, Q99489, Q9ClL2, Q9JXF8, Q9V5P1, Q9VM80, Q9X7P6, QgY7N4, Q9Z1MS, Q9Z302, and U60066. If applicant claims one of the sequences identified by accession number, applicant must either submit a new CRF identifying each accession number by SEQ ID NO, or must claim the sequence by name (see below under sequence compliance).

Claims that do not read on the elected sequence will be considered withdrawn. Applicant is advised that a reply to this requirement must include an identification of the sequence that is selected. An election that does not identify the sequence selected will be considered

nonresponsive. This requirement is not to be construed as an election of species since each nucleotide sequence is not a member of a single genus of invention but constitutes independent and patentably distinct inventions.

If any of the SEQ ID NOS: 2, 4, 6, 8, 10, 12 or 14 corresponds to one of the accession numbers recited in claim 5, it will be rejoined with the SEQ ID NO.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Sequence Compliance

There are sequences in claim 5 and in the specification that are not present in the sequence listing.

MPEP § 1.821 states:

> (d) Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:" in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application.

Accession numbers cannot be searched by the USPTO. Applicant needs to provide a substitute computer readable form (CRF) copy of a "Sequence Listing" which includes all of the sequences recited in the claims and specification of the instant application which are encompassed by these rules, a substitute paper copy of that "Sequence Listing", an amendment directing the entry of that paper copy into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. §§ 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). For

rules interpretation Applicant may call (571) 272-2510. See M.P.E.P. 2422.04. For CRF submission help, call (571) 272-2501/2583.

Alternatively, Applicant may claim the accession numbers by name corresponding to each accession number.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara whose telephone number is (571) 272-0878. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eileen B. O'Hara/
Primary Examiner
Art Unit 1638